

REMARKS

Claims 1, 2, 16, 22-27, 31, and 44-73 are pending in this application after this Amendment. In light of the amendments and remarks made herein, Applicants respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to claim 45 based on minor informalities. The Examiner further rejected claim 30 under 35 U.S.C. § 102(e) as being anticipated by *Chan et al.* (USP 6,061,051); and rejected claims 1-2 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Chan et al.* in view of *Flores et al.* (USP 6,310,988). Applicants respectfully traverse these rejections.

Applicants wish to thank the Examiner for allowing claims 16, 24-27, 31, and 44-71.

Claim Objections

With regard to the Examiner's objection to claim 45, asserting it depends on canceled claim 43, by this Amendment, Applicants have amended claim 45 to depend from claim 16. Based upon this amendment, it is respectfully requested that the outstanding objection be withdrawn.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claim 30 under 35 U.S.C. § 102(e) as being anticipated by *Chan et al.* By this Amendment, Applicants have canceled claim 30 without prejudice or disclaimer to the subject

matter contained therein. Based upon this cancellation, it is respectfully requested that the outstanding rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

In support of the Examiner's rejection of claim 1, it appears that the Examiner is asserting that *Chan et al.* teaches an absolute position-coding pattern causing an input unit arrangement to switch from a first to a second function, citing to col. 8, lines 1-19, col. 11, lines 48-63, and col. 13, line 66 - col. 14, line 4. The Examiner admits that *Chan et al.* does not expressly disclose an input device for recording images including a signal processing device that detects a predetermined position-coding pattern in one of the images. The Examiner relies on *Flores et al.* to cure the deficiencies of the teachings of *Chan et al.*, asserting that *Flores et al.* teaches this claim element, citing to col. 11, lines 30-62, col. 14, lines 33-67, and col. 15, lines 9-25. The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate *Flores et al.*'s camera pen into *Chan et al.*'s system so as to capture a user selected portion on the glyph address carpet, citing to col. 11, lines 31-33. Applicants respectfully disagree with the Examiner's characterization of these references.

The disclosure of *Chan et al.* is directed to a command set for a touchpad pen input mouse. A method and system is provided for for issuing pen input commands from a computer system to a controller

for a touchpad to initialize the controller to the desired operating mode for the touchpad. The touchpad may emulate the function of a mouse pointing device or provide absolute coordinates of a pointed object such as a human finger, a stylus, or a pen upon the touchpad. (Abstract).

Specifically, *Chan et al.* provides for a touchpad interface of Fig. 1 being a touchpad pen-input controller. The touchpad pen-input controller has a touchpad driver which provides a constant current as a stimulus to the touchpad. (Col. 8, lines 46-49). As a pointed object such as a finger, a stylus, or a pen is moved across the touchpad, the resistance of the resistive film as described in Fig. 1 changes causing a voltage at the current sources connected to the X+ line and Y+ line and at the current sinks connected to the X- line and the Y- line to vary. The voltage variation will be proportional to the distance that the contact is from the peripheral edges of the touchpad where the X+ and Y+ lines and the X- and Y- are attached. (Col. 8, lines 59-67).

The pen input has a command interpreter and execution unit connected to the protocol selector to receive and interpret pen input commands from the computer system. The pen input commands will set the auto cursor mode and boundaries for the edge zone and the dead zone upon the touchpad, and the mode of the pen input mouse controller is to operate, whether the pen input mouse

controller is to send the mouse protocol or the pen input computer interface protocol to the computer system. (Col. 11, lines 48-59).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an input unit arrangement with a mouse function mode and an input function mode comprising an image recording device for recording images and a signal processing device for processing the images to achieve the mouse function mode and the input function mode, wherein the input unit arrangement is arranged to switch from the input function mode to the mouse function mode when the signal processing device detects a predetermined position-coding pattern in one of the images. As noted above, *Chan et al.* teaches that the computer system sends commands to the pen input to identify what mode the pen input is to operate. There is no teaching or suggestion in *Chan et al.* that is directed to the pen input itself being able to switch between modes nor is there any teaching or suggestion of an absolute position coding pattern. Further, there is no teaching or suggestion in *Chan et al.* that is directed to switching modes when the signal-processing device detects a predetermined position-coding pattern in one of the images.

Flores et al. fails to cure the deficiencies of the teachings of *Chan et al.*, assuming these references are combinable, which Applicants do not admit.

Although *Flores et al.* teaches, *arguendo*, utilizing a self-clocking glyph code pattern, there is no teaching or suggestion in *Flores et al.* that is directed to switching modes based upon a signal processing device detecting a predetermined position-coding pattern. Further, there is no teaching or suggestion in *Flores et al.* that is directed to the input unit arrangement switching from modes based upon a detection of a predetermined position-coding pattern. As neither of the references, either alone or in combination, teach or suggest all of the claimed elements as provided in the claims, it is respectfully submitted that claim 1 is not anticipated by *Chan et al.* in view of *Flores et al.*

In addition to the above-noted deficiency in the Examiner's rejection under 35 U.S.C. § 103, it is respectfully submitted that the teachings of the two references cited by the Examiner are not combinable. As noted above, the disclosure of *Chan et al.* is directed to a touchpad controller to emulate the functions of a mouse pointing device. The touchpad can be used to provide absolute coordinates of a pointed object such as a human finger, a stylus, or a pen upon the touchpad.

In contrast, the disclosure of *Flores et al.* is directed to a method and apparatus for a camera pen. A graphical user interface may be implemented using a glyph address carpet. The interface comprises sensory indicia and a background which comprises a glyph

address carpet. The glyphs can be decoded to provide unique address information for each location. (Col. 10, lines 51-62).

Camera pen 1710 may be used to capture a portion of the glyph address carpet. When the user presses button 1714, a signal travels through the circuitry of the mouse 1728 to cursor control 1714. The signal causes processor 1722 to run a program that directs frame capture 1728 to capture the image from camera pen 1710. (Col. 11, lines 26-50).

Based upon the above teachings, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate *Flores et al.*'s camera pen into *Chan et al.*'s system so as to capture a user selected portion on the glyph address carpet as suggested by the Examiner. The touchpad of *Chan et al.* may be used with any pointed object such as a human finger. As *Chan et al.*'s touchpad utilizes current to identify the location of the pointed object, there would be no need to utilize a camera pen. As such, it is respectfully submitted that there is no motivation to combine the references as asserted by the Examiner.

In making such a combination as asserted, it is respectfully submitted that a substantial modification in the functionality of the system of the *Chan et al.* reference would need to be made and, ultimately, would render the apparatus of *Chan et al.* inoperative.

This supports Applicants' assertion that one of ordinary skill in the art would not be motivated to make this modification.

Finally, if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 439 (CCPA 1959). The apparatus of *Chan et al.* is directed to a touchpad that determines the location of a pointed object by detecting its presence at a sensed location. To suggest modifying the invention to where a pen device captures images and sends the images to a system that determines its position based upon a self-clocking glyph would change the principal operation of the apparatus of *Chan et al.* As such, the application of the teachings of the references as suggested by the Examiner is insufficient to render the claims *prima facie* obvious. As such, no *prima facie* case is made and the combination cannot fairly be made. It is respectfully requested that the outstanding rejections be withdrawn.

It is respectfully submitted that claim 2 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. It is further respectfully submitted that claim 22 contains elements similar to those discussed above with regard to claim 1 and, thus, claim 22, together with claims dependent thereon, are not obvious for the reasons set forth above.

By this Amendment, Applicants have added new claims 72-73 for consideration by the Examiner. It is respectfully submitted that these claims are allowable over the art as cited.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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